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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,951	11/13/2003	Larry J. Pacey	WMS-029	9624
30223	7590	06/03/2008		
NIXON PEABODY LLP 161 N. CLARK STREET 48TH FLOOR CHICAGO, IL 60601-3213			EXAMINER THOMAS, ERIC M	
			ART UNIT	PAPER NUMBER
			3714	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/712,951

Applicant(s)

PACEY, LARRY J.

Examiner

Eric M. Thomas

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 11/13/03, 12/2/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This is in response to the amendments filed on 4/30/08. Claims 1 - 20 are now pending in the current application.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singer et al. (U.S. 6,604,740) in view of Luciano (U.S. 6,050,895).

2. Regarding claims 1, 6, and 14, Singer discloses a method of conducting a wagering game on a gaming machine, comprising: receiving a wager from a player to initiate play of the wagering game (col. 8, lines 54 – 58), randomly selecting a plurality of symbols to form a first array (col. 10, lines 40 – 43), displaying the first array and identifying winning symbols in the first array that form any first winning combination (fig. 6a), awarding the player for the first winning combination in the first array (col. 3, lines 1 – 5), replacing one or more of the winning symbols in the first array that form the first winning combination with a randomly determined replacement symbol to form a second array (col. 5, lines 1 – 6), displaying the second array and identifying winning symbols in

the second array that form any second winning combination (fig. 6b) and awarding the player for the second winning combination in the second array (col. 3, lines 1 – 5).

Regarding claim 2, Singer discloses wherein less than all of the winning symbols that form the first winning combination are replaced (col. 5, lines 1 – 6).

Regarding claim 3, Singer discloses wherein a wild symbol is one of the winning symbols forming the first winning combination and is not replaced (col. 5, lines 1 – 6).

Regarding claims 4, 5, 13, and 16, Singer discloses a gaming machine and method of conducting a wagering that includes a basic wagering game and a bonus wagering game that has a pay structure that is paid in accordance with a pay table, (col. 5, lines 6 – 10; col. 9, lines 2 – 6), but is silent on the issue of containing a second pay table. In a related art, however, Luciano provides a gaming device that teaches the use of a second pay table (col. 7, lines 20 - 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Luciano into the art disclosed by Singer in order to provide different odds of winning rewards or prizes.

3. Regarding claims 7 and 8, Singer discloses a method of conducting a wagering game on a gaming machine, comprising: receiving a wager from a player to initiate play of the wagering game (col. 8, lines 54 – 58), randomly selecting a plurality of symbols to form a first array (col. 10, lines 40 – 43), displaying the first array and identifying winning symbols in the first array that form any first winning combination (fig. 6a), awarding the player for the first winning combination in the first array (col. 3, lines 1 – 5), replacing one or more of the winning symbols in the first array that form the first winning

combination with a randomly determined replacement symbol to form a second array (col. 5, lines 1 – 6), displaying the second array and identifying winning symbols in the second array that form any second winning combination (fig. 6b) and awarding the player for the second winning combination in the second array (col. 3, lines 1 – 5), but is silent on the issue of containing a second pay table. In a related art, however, Luciano provides a gaming device that teaches the use of a second pay table that could be used as the pay table for the bonus game (col. 7, lines 20 - 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Luciano into the art disclosed by Singer in order to provide different odds of winning rewards or prizes.

Regarding claim 9, Singer discloses a method of conducting a wagering game that discloses a wild symbol as a winning symbol on at least one of any winning combination and second winning combination along one or more pay lines (col. 11, lines 13 – 17 and fig. 9b).

Regarding claims 10, 17, and 18, Singer discloses a method of conducting a wagering game on a gaming machine, comprising: receiving a wager from a player to initiate play of the wagering game (col. 8, lines 54 – 58), randomly selecting a plurality of symbols to form a first array (col. 10, lines 40 – 43), displaying the first array and identifying a first winning symbol in the first array that creates any first winning outcome (fig. 6a), awarding the player for the first winning outcome (col. 3, lines 1 – 5), replacing the first winning symbol with a randomly determined first replacement symbol to form a second array (col. 5, lines 1 – 6), displaying the second array and identifying a second

winning symbol in the second array that creates any second winning outcome (fig. 6b), and awarding the player for the second winning outcome (col. 3, lines 1 – 5), and a data input apparatus that is used to receive the player selections of at least one of the plurality of pay lines (col. 17, lines 23 – 26).

Regarding claim 11, Singer discloses further including: replacing the second winning symbol with a randomly determined second replacement symbol to form a third array, displaying the third array and identifying a third winning symbol in the third array that forms any third winning outcome (fig. 6c), and awarding the player for the third winning outcome (col. 3, lines 1 – 5).

Regarding claims 12, 15, and 19, Singer discloses a method of conducting a wagering game on a gaming machine, comprising: receiving a wager from a player to initiate play of the wagering game (col. 8, lines 54 – 58), randomly selecting a plurality of symbols to form a first array (col. 10, lines 40 – 43), displaying the first array and identifying a first winning symbol in the first array that creates any first winning outcome (fig. 6a), awarding the player for the first winning outcome (col. 3, lines 1 – 5), replacing the first winning symbol with a randomly determined first replacement symbol to form a second array (col. 5, lines 1 – 6), displaying the second array and identifying a second winning symbol in the second array that creates any second winning outcome (fig. 6b), and awarding the player for the second winning outcome (col. 3, lines 1 – 5), and a data input apparatus that is used to receive the player selections of at least one of the plurality of pay lines (col. 17, lines 23 – 26), but is silent on the issue of containing a second pay table. In a related art, however, Luciano provides a gaming device that

teaches the use of a second pay table that could used as the pay table for the bonus game (col. 7, lines 20 - 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Luciano into the art disclosed by Singer in order to provide different odds of winning rewards or prizes.

Regarding claim 20, Singer discloses a computer readable storage medium that is capable of being encoded with instructions for performing the tasks of the gaming system (col. 18, lines 59 – 63).

Response to Arguments

4. Applicant's arguments with respect to claims 1 - 20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric M. Thomas whose telephone number is (571) 272-1699. The examiner can normally be reached on 7a.m. - 3p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714